REMARKS

Claims 1-43 are currently pending in the subject application and are presently under consideration. Claims 1, 9, 16, 19, 23 and 26 have been amended herein for clarification purposes, and these amendments are not intended to narrow the scope of such claims but rather to emphasize applicants' novel invention. Favorable reconsideration of the subject patent application is respectfully requested in view of the following comments.

I. Rejection of Claims 1-3, 9, 19-21, 23, 26, 28, 34, 37, 41 and 43 Under 35 U.S.C. §102(b)

Claims 1-3, 9, 19-21, 23, 26, 28, 34, 37, 41 and 43 stand rejected under 35 U.S.C. §102(b) as being anticipated by Forscher, Stewart, "CyberNag (Mailmen Division) Project Notebook"(Feb. 21, 1996). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Forscher does not teach or suggest each and every limitation of applicants' claimed invention.

> For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (*quoting Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Independent claims 1, 19, and 26 recite ***generating a priority of a document based on a trained document classifier*** and ***alerting a user to the document based on a predetermined criteria***. The cited reference does not teach or suggest such claimed features of the subject invention.

Applicants' claimed invention provides a learning model that uses multiple factors as inputs to a *trained* document classifier and a probabilistic model to determine priority of a document based on a combination of the factors. These factors can be words, phrases, symbols, document sender, other recipients of the document, time, document length, etc. Furthermore, alerting of the user can be based on a cost-benefit analysis to

determine the appropriate time, location, and method of alert delivery. The alert can be directed to the user's personal computer, personal digital assistant, phone, fax, pager, etc., or a combination thereof. The type and intensity of the alert can also vary based upon the urgency of the document.

As noted *supra*, Forscher does not teach or suggest such aspects of the claimed invention. Rather, Forscher merely teaches a *static* user defined model where a user enters keywords into a file and assigns each keyword a priority. The system then looks for the keywords in the document and assigns a priority based upon the highest priority keyword found - this is a simplistic form of prioritization and alerting. Forscher does not teach or suggest a sophisticated learning prioritization and alerting model based on a ***trained*** classifier as in applicants' claimed invention.

Claims 3, 21, 28, and 37 recite employment of a sound in connection with an alert that can vary in type and/or intensity based on priority of the document that the alert is associated with. Forscher does not explicitly describe creating an audible alert as in the subject claims let alone varying a sound in type and/or intensity based on the document priority.

In view of at least the above, it is respectfully submitted that Forscher does not teach or suggest applicants' claimed invention as recited in independent claims 1, 19, and 26 (and claims 2, 3, 9, 20, 21, 23, 28, 34, 37, 41, and 43 which respectively depend there from). Accordingly, withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 4-7, 29 and 38-40 Under 35 U.S.C. §103(a)

Claims 4-7, 29 and 38-40 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Forscher as applied in claims 1, 19, and 26, in view of Henderson *et al.* (US 6,185,603 B1). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Niether Forscher nor Hendersen *et al.*, alone or in combination, teach or suggest applicants' claimed invention.

> To reject claims in an application under §103, an examiner must establish a *prima facie* case of obviousness. A *prima facie* case of

> obviousness is established by a showing of three basic criteria. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP §706.02(j). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicants' disclosure. *See In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

The subject claims respectively depend from independent claims 1, 19 and 26, and as noted *supra* Forscher does not teach or suggest applicants' sophisticated document prioritization and alerting invention that employs a trained classifier as recited in these independent claims. Henderson *et al.* does not make up for the aforementioned deficiencies of Forscher. Rather, Henderson *et al.* is concerned with where to deliver a message and appearance of alerts, and prioritization of a message based on priority assigned by a sender. Henderson *et al.* does not consider any factors associated with the message or the recipient to determine priority in relation to other messages the recipient has received let alone employing a ***trained machine learning system (e.g., classifier)*** in connection therewith.

It is readily apparent that the combination of Forscher and Henderson *et al.* does not make obvious applicants' invention as recited in the subject claims. Accordingly, withdrawal of this rejection is respectfully requested.

III. Rejection of Claims 8, 10-12, 22, 24-25, 27, 30-33 and 42 Under 35 U.S.C. §103(a)

Claims 8, 10-12, 22, 24-25, 27, 30-33 and 42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Forscher as applied in claims 1, 19, and 26, in view of Lewis, "Evaluating and Optimizing Autonomous Text Classification Systems", 1995 ACM. It is respectfully submitted that this rejection should be withdrawn for at least the

following reasons. Neither Forscher nor Lewis, alone or in combination, teach or suggest each and every limitation of applicants' claimed invention.

As noted above regarding independent claims 1, 19 and 26, Forscher does not teach or suggest applicants' invention as recited in the subject claims which respectively depend from these independent claims. Lewis does not make up for the deficiencies of Forscher - Lewis teaches employment of a binary-based classification scheme to evaluate effectiveness of text classifier(s). Lewis defines an effectiveness measure that is applied to a set of decisions, followed by the system's continuous estimation of such effectiveness.

With respect to claims 8 and 22, Forscher does not teach opening an agent based on predetermined criteria as conceded in the Office Action. Contrary to the Examiner's assertions, Lewis does not teach that alerting the user comprises opening an agent. Rather, Lewis describes an *agent* that monitors messages and *initiates an alert* when a relevant message appears. Applicants' claimed invention describes the ***alert initiating an agent*** that performs a task.

In regards to claims 10, 24, and 42, it is conceded in the Office Action that Forscher and Lewis do not state determining when the user is busy. Applicants' representative respectfully disagrees with the contention that Lewis's description of taking into account losses associated with only analyzing retrieved documents is equivalent to determining if the user is busy. Again, Lewis is concerned with a binary-based classification approach to assess other classification schemes and thus takes into consideration losses associated with such binary-based classification approach if an incomplete set of data is employed (*e.g.*, making the analysis only based on retrieved documents). Applicants' claimed invention determines if a user is busy (for example, through several possible indicators, such as sensors around the computer, acoustical analysis, keyboard activity, office phone activity, user location device, scheduling information available in the calendar, etc.), and ***upon determining that the user is busy, alerting the user only upon determining that the priority of the document is greater than the predetermined threshold.*** It is clear that the cited references alone or in combination do not teach or suggest such aspects of applicants' claimed invention.

Claims 11, 12 and 25 respectively relate to displaying a plurality of documents according to a priority of each document, wherein displaying the plurality of documents

comprises displaying only documents having a priority greater than a predetermined threshold. The Office Action concedes Forscher does not teach displaying a plurality of documents having a greater priority than a threshold, but asserts that it would have been obvious to someone skilled in the art at the time of the invention to add such features recited in applicants' subject claim to the teachings of Lewis to create the claimed invention. It is respectfully submitted that the Examiner appears to be impermissibly employing applicants' specification as a 20/20 hindsight-based roadmap to effect the combination of references as well as supply teachings missing from the references.

> The prior art items themselves must suggest the desirability and thus the obviousness of making the combination without the slightest recourse to the teachings of the patent or application. Without such independent suggestion, the prior art is to be considered merely to be inviting unguided and speculative experimentation which is not the standard with which obviousness is determined. *Amgen, Inc. v. Chugai Pharmaceutical Co. Ltd.*, 927 F.2d 1200, 18 USPQ2d 1016 (Fed. Cir. 1991); *In re Laskowski*, 871 F.2d 115, 117, 10 USPQ2d 1397, 1398 (Fed. Cir. 1989); *In re Dow Chemical Co.*, 837 F.2d 469, 473, 5 USPQ2d 1529, 1532 (Fed. Cir. 1988); *Hodosh v. Block Drug*, 786 F2f at 1143 n. 5., 229 USPQ at 187 n. 4.; *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1985).

In general, the rationale proffered to combine the references in the subject Office Action is to achieve benefits identified in applicants' specification, to overcome problems associated with conventional systems/methods. This is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicants' specification. This sort of rationale has been condemned by the CAFC; *see, for example, Panduit Corp. v. Dennison Manufacturing Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987).

Claims 30 and 31 respectively relate to providing the user a summary of documents including the documents that have arrived while the user was away or busy within another application, and lowering the level of summarization as the priority of the document increases – this mitigates non-delivery of critical information. As noted in the

Office Action, Forscher does not teach providing the user a summary of documents including the documents that have arrived while the user was away or busy within another application. Lewis does not make up for the deficiencies of Forscher. Lewis describes forwarding or alerting of documents, but does not teach or suggest creating a ***summary of documents*** let alone ***varying the level of summarization based a function of document priority*** as in the subject claims.

In regards to claim 32 and 33, the Office Action concedes Forscher does not teach an interaction context. Likewise, Lewis also does not teach an interaction context, but rather simply describes alerting when a document is considered to be relevant. The interaction context of applicants' claimed invention provides a window of time after the user has been alerted to perform a gesture, such as for example a mouse wiggle, to bring up more detail concerning the document than was provided in the alert.

In view of at least the foregoing, it is respectfully submitted that the combination of Forscher and Lewis does not make obvious applicants' invention as recited in the subject claims, and this rejection should be withdrawn.

IV. Rejection of Claims 13-14, 16 and 35-36 Under 35 U.S.C. §103(a)

Claims 13-14, 16 and 35-36 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Forscher in view of Cohen, "Learning Rules that Classify E-mail", 1996 and Platt (US 6,327,581). It is respectfully submitted that this rejection should be withdrawn for at least the following reasons. Neither Forscher, Cohen, nor Platt, alone or in combination, teach or suggest each and every limitation of applicants' claimed invention let alone there being no motivation to combine the references as suggested other than *via* employment of applicants' specification as a 20/20 hindsight-based roadmap to achieve the purported combination.

Independent claim 13 recites similar limitations as discussed *supra* with respect to claims 1, 19 and 26. Accordingly, the aforementioned deficiencies of Forscher apply to this claim as well, and neither Cohen nor Platt makes up for the above-noted deficiencies. Cohen merely relates to using classifiers in connection with categorizing e-mails *via keyword-spotting rulesets* so as to place respective e-mails in proper folders. Moreover, it

is noted that claims 13 and 35 recite a Bayesian classifier, and Cohen teaches away from employment of such type of classifier – "[I]t should be noted that these rulesets are *quite different* from the classifiers constructed by more common text categorization learning methods, such as *naïve Bayes*..." (*see* page 1, col. 2 of Cohen). A prior art reference must be considered in its entirety, *i.e.*, as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). Platt teaches a method for building a support vector machine classifier. Neither Cohen nor Platt teach or suggest a sophisticated trained classifier-based document prioritization and alerting model as in applicants' claimed invention.

Claim 14 recites similar limitations as discussed *supra* with respect to claims 3, 21, 28, and 37. Accordingly, the aforementioned deficiencies of Forscher apply to this claim as well, and neither Cohen nor Platt makes up for the above-noted deficiencies.

In view of at least the above, it is respectfully submitted that the combination of Forscher, Cohen, and Platt do not make obvious the subject invention as recited in independent claim 13 (and claims 14 and 16 dependent there from), and claims 35-36 (which depend from independent claim 26). Accordingly, withdrawal of this rejection is respectfully requested.

V. Rejection of Claims 15, 17 and 18 Under 35 U.S.C. §103(a)

Claims 15, 17 and 18 stand rejected under 35 U.S.C. §103(a) as being obvious over Forscher in view of Cohen, Platt and Lewis. It is respectfully requested that this rejection be withdrawn for at least the following reasons. The cited references (alone or in combination) fail to teach or suggest each and every limitation of applicants' claimed invention. Moreover, as noted above, the combination of references appears to rely on applicants' specification as a 20/20 hindsight-based roadmap to achieve the purported combination(s).

Claim 15 recites similar limitations as discussed *supra* with respect to claims 8 and 22. Accordingly, the aforementioned deficiencies of Forscher and Lewis apply to this claim as well, and neither Cohen nor Platt makes up for the above-noted deficiencies.

Claim 17 recites similar limitations as discussed *supra* with respect to claims 10, 24 and 42. Accordingly, the noted deficiencies of Forscher and Lewis apply to this claim as well, and neither Cohen nor Platt makes up for such deficiencies.

Claim 18 depends from independent claim 13. Accordingly, the aforementioned deficiencies of Forscher, Cohen and Platt apply to this claim as well, and Lewis does not cure these deficiencies.

This rejection should be withdrawn.

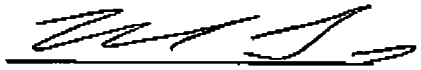
CONCLUSION

The present application is believed to be in condition for allowance in view of the above comments and amendments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063.

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicants' undersigned representative at the telephone number listed below.

Respectfully submitted,
AMIN & TUROCY, LLP



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